



Patent
Attorney's Docket No. 017753-154

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OCT 28 2002

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Therese de BIZEMONT *et al.*) Group Art Unit: 1635
Application No.: 09/836,439) Examiner: Richard A. Schnizer
Filed: April 17, 2001) Confirmation No.: 5851
For: GENE THERAPY WITH CHIMERIC)
OLIGONUCLEOTIDES DELIVERED)
BY A METHOD COMPRISING A STEP)
OF IONTOPHORESIS)

RESPONSE TO RESTRICTION REQUIREMENT TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed is a Response to Restriction Requirement for the above-identified patent application.

- A Petition for Extension of Time is also enclosed.
- A Terminal Disclaimer and a check for [] \$55.00 (2814) [] \$110.00 (1814) to cover the requisite Government fee are also enclosed.
- Also enclosed is _____
- Small entity status is hereby claimed.
- Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the [] \$370.00 (2801) [] \$740.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- Applicant(s) previously submitted ___, on ___, for which continued examination is requested.
- Applicant(s) request suspension of action by the Office until at least ___, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.
- No additional claim fee is required.

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[] An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× \$18.00 (1202) =	
Independent Claims		MINUS =		× \$84.00 (1201) =	
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					

[] A claim fee in the amount of \$_____ is enclosed.

[] Charge \$_____ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
Deborah H. Yellin
Registration No. 45,904

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(703) 836-6620

Date: October 24, 2002



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ELECTION
Patent

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DELIVERED BY A METHOD)
COMPRISING A STEP OF)
IONTOPHORESIS)

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Response to Restriction Requirement is in complete response to the Official Action (Restriction Requirement) mailed on September 24, 2002 (Paper No. 14). This Response is timely filed by the October 24, 2002 due date.

The Examiner has required the election of a single Group, to which the claims will be restricted if no generic claim is held to be allowable. Applicants hereby elect, with traverse, Group I (i.e., claims 1-21), drawn to methods of delivering an oligonucleotide *in vivo* to cells of an animal by iontophoresis.

Turning now to the restriction requirement, Applicants respectfully traverse. For the reasons set forth below, Applicants request that the restriction requirement be modified so that the inventions of Groups I-IX will be examined together.

Under M.P.E.P. § 803, a restriction is proper if the subject matter can be restricted into one of two or more claimed inventions, and these inventions are either independent (M.P.E.P. § 806.04) or distinct (M.P.E.P. § 806.05). However, the second element for a restriction requirement to be proper is that if the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent and distinct inventions. Applicants submit that a search of each Group as set forth in the outstanding Office Action would not be burdensome to the Examiner. All of the claims relate to chimeric oligonucleotides delivered via iontophoresis. A search for those claims directed to the chimeric oligonucleotide would overlap a search for claims directed to methods of using these name oligonucleotides.

Furthermore, the Office has not set forth an explanation of how a search of the claimed invention would be burdensome. Accordingly, Applicants assert that a proper restriction under M.P.E.P. § 803 has not been set forth with regard to the originally presented claims, the elections herein are provisional. The restriction should be withdrawn or, at the very least, reconsidered.

Withdrawal of the restriction requirement and rejoinder of the claims of Groups I-XV, and further and favorable consideration of all the claims of record on the merits is respectfully requested.

CONCLUSION

Applicants submit that the present application is fully in condition for examination. An early examination on the merits is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:



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